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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,519	12/05/2003	Thomas Matthew McCann	1322/37/2/2	2411

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EXAMINER

SOBUTKA, PHILIP

ART UNIT	PAPER NUMBER
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2618

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,519

Applicant(s)

MCCANN ET AL.

Examiner

Philip J. Sobutka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/5/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed December 05, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Note that the non-patent files are missing from the parent application file and have apparently been lost.

Therefore they cannot be considered unless re-filed.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 28 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 24 of prior U.S. Patent No. 6,662,017. This is a double patenting rejection.

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4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 23,27, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24, respectively of U.S. Patent No. 6,662,017. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the patented claims require specific routing rules, it would have been obvious to one of ordinary skill in the art to use the more generic arrangement of the instant claims in order increase the versatility of the arrangements.

6. Claims,29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25-27 respectively of U.S. Patent No. 6,662,017. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the patented claims require an HLR or specific

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routing rules, it would have been obvious to one of ordinary skill in the art to use the more generic arrangement of the instant claims in order to increase the versatility of the arrangements.

7. Claims 1-5,8-17, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5,6-15, respectively of U.S.

Patent No. 6,662,017. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the patented claims require an HLR or specific routing rules, it would have been obvious to one of ordinary skill in the art to use the more generic arrangement of the instant claims in order to increase the versatility of the arrangements.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, the claim is merely descriptive and adds no limitation.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1,7-9,13-18,21, are rejected under 35 U.S.C. 102(e) as being anticipated by Op Den Camp et al. (WO 99/11087).

Consider claim 1. Op Den Camp et al. discloses a technique for processing messages in a mobile communications network comprising receiving a first message relating to a communication, the first message including a called party identifier and being destined for a mobile services node in the network (page 5, lines 17-20), analyzing information in the first message to determine whether number portability processing is required for the first message (page 5, lines 20-29), in response to determining that number portability processing is required for the first message, performing a lookup in a first database based on the called party identifier to determine whether the called party has been ported out of an area serviced by the mobile services node (page 5, line 29 - page 6, line 32), in response to determining that the called party has been ported out of the area serviced by the mobile services node, analyzing information in the first message to determine whether a reply is required for the first message and in response to determining that a reply is required for the first message, formulating the reply based on information extracted from the first database (page 5, line 33 - page 6, line 17).

As to claim 7, Op Den Camp also teaches the first message being a SMS message (page 7, lines 12-17).

As to claim 8, Op Den Camp teaches the called party identifier including the MSISDN (page 8, line 35 - page 9, line 9).

As to claim 9, note that the called party identifier can also include a telephone number associated with a wire line network subscriber.

As to claim 13, Op Den Camp also teaches the analyzing information including examining a global title indicator parameter (page 9, lines 1-4).

As to claims 14-15,17,18 it is also considered that the analyzing information to determine whether number portability processing is required includes examining a numbering plan or a nature of address for indicating a home location register or short message service center since Op Den Camp discloses that the prefixes of numbers are examined (page 3, lines 8-21).

As to claims 16,21, Op Den Camp also discloses the feature of the lookup being performed in the first database based on a service entity, such as the location register and having entries that are exception to ranges of called party identifiers (page 5, line 17 - page 6, line 17, particularly page 5, line 33 - page 6, line 2).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 2-6,10-12,19,20,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Op Den Camp et al.

As to claims 2-6, Op Den Camp et al. discloses everything claimed as explained above except for the first message being received includes a signaling system 7 (SS7) message, a send routing information (SRI) signaling message in which the above reply is a SRI acknowledge signaling message or a session initiation protocol (SIP) signaling message as recited in claims 2-6,24-25,29-30 and 32. However, such signaling message techniques are common and well known in the telecommunication art and therefore would have been obvious to one having ordinary skill in the art since one would want to select a signaling technique that best suits the needs of the system.

As to claims 10-11, Op Den Camp lacks a teaching of the called party identifier including an email address or an IP address as recited in claims 10-11, since Op Den Camp et al. teaches that other devices can be used with the system, then it would have been obvious to one having ordinary skill in the art to include email and IP addresses in order to increase the flexibility of the system.

As to claims 12,19,20 regarding the feature of the analyzing information in the first message to determine whether number portability processing is required includes examining a translation type parameter or mobile application part (MAP) operation code

parameter. Since these parameters commonly contain particular portability information, then it would have been obvious to one of ordinary skill in the art to specifically use these parameters in determining portability processing in order to more quickly determine if portability processing is needed.

As to claim 22, Op Den Camp in view of Patel lacks a teaching of performing a second lookup in a second database in response to failure in the first database. Note that Op Den Camp teaches the use of a second database (Op Den Camp see especially fig 3). It would have been obvious to one of ordinary skill in the art to search a second database in the event the entry was not found in the first in order to provide extra storage space while ensuring that the extra storage was properly utilized.

15. Claims 23-27,29-33, are rejected under 35 U.S.C. 103(a) as being unpatentable over Op Den Camp et al. (WO 99/11087) in view of Patel (US 6,049,714).

Consider claim 23, Op Den Camp et al. discloses a technique for processing messages in a mobile communications network comprising receiving a first message relating to a communication, the first message including a called party identifier and being destined for a mobile services node in the network (page 5, lines 17-20), analyzing information in the first message to determine whether number portability processing is required for the first message (page 5, lines 20-29), in response to determining that number portability processing is required for the first message, performing a lookup in a first database based on the called party identifier to determine whether the called party has been ported out of an area serviced by the mobile services

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node (page 5, line 29 - page 6, line 32), in response to determining that the called party has been ported out of the area serviced by the mobile services node, analyzing information in the first message to determine whether a reply is required for the first message and in response to determining that a reply is required for the first message, formulating the reply based on information extracted from the first database (page 5, line 33 - page 6, line 17). Op Den Camp lacks a teaching of the lookup being performed at a routing node. Patel teaches an auxiliary routing node for a mobile system that can perform look-up and routing for ported number messages (Patel see especially fig 3, col 4, line 54 – col 5, line 20, col 6, lines 12-21). Patel teaches that this allow for the MSC to access SCP's using AIN protocols, and SS7 signaling (Patel see especially col 1, lines 50-64, col 5, lines 38-47). It would have been obvious to one of ordinary skill in the art to modify Op Den Camp to use the node as taught by Patel in order to allow for the MSC to access SCP's using AIN protocols, and SS7 signaling.

As to claim 33, it is also considered that the analyzing information to determine whether number portability processing is required includes examining a numbering plan or a nature of address for indicating a home location register or short message service center since Op Den Camp discloses that the prefixes of numbers are examined (page 3, lines 8-21).

As to claims 26-27, Op Den Camp also discloses the feature of the lookup being performed in the first database based on a service entity, such as the location register and having entries that are exception to ranges of called party identifiers (page 5, line 17 - page 6, line 17, particularly page 5, line 33 - page 6, line 2).

As to claims 24,25,29,30,32,34 Op Den Camp et al. in view of Patel teaches utilizing SS7 messages, Op Den Camp in view of Patel lacks a teaching of a send routing information (SRI) signaling message in which the above reply is a SRI acknowledge signaling message or a session initiation protocol (SIP) signaling message as recited in claims 2-6,24-25,29-30 and 32. However, such signaling message techniques are common and well known in the telecommunication art and therefore would have been obvious to one having ordinary skill in the art since one would want to select a signaling technique that best suits the needs of the system.

As to claim 31, Op Den Camp also teaches the first message being a SMS message (page 7, lines 12-17).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Sobutka whose telephone number is 571-272-7887. The examiner can normally be reached Monday through Friday from 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4711.

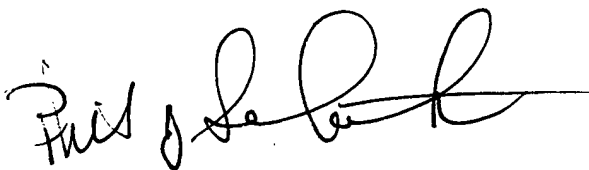
18. The central fax phone number for the Office is 571-273-8300.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number.

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CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Philip J. Sobutka", with a stylized, flowing script.

PHILIP J. SOBUTKA
PATENT EXAMINER

Philip J Sobutka

(571) 272-7887